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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,914	09/11/2003	David Wayne Jennings	194-28620-US	6010
24923 7590 02/16/2007 PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA, SUITE 700 HOUSTON, TX 77057-1130			EXAMINER FIGUEROA, JOHN J	
			ART UNIT	PAPER NUMBER
			1712	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/16/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/659,914

Applicant(s)

JENNINGS, DAVID WAYNE

Examiner

John J. Figueroa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The 35 U.S.C. 112, first paragraph rejections in items 2 and 9-11 on pages 2 and 4-6 of the Office Action of August 22, 2006, hereinafter 'OA' and the 35 U.S.C. 112, second paragraph, rejection in item 12 on page 6 of OA, have been withdrawn in view of the amendment to the claims in Applicant's amendment/response of November 22, 2006, hereinafter 'Response'.
2. The 35 U.S.C. 112, first paragraph, rejection of claim 1 (and claims 3, 5-7 and 9-21 that depend therefrom) is maintained for the reasons previously made of record in item 8 on page 3 of OA.
3. The 35 U.S.C. 102(e) rejection of claims 1, 3, 5-7 and 12-21 as anticipated by United States Patent Number (USPN) 6,593,426 to Krull et al., hereinafter 'Krull', is maintained for the same reasons set forth and previously made of record in item 4 on page 2 of OA and in item 13 on page 8 of the Office Action of March 13, 2006.
4. The 35 U.S.C. 102(b) rejection of claims 1, 3, 5-7 and 9-21 as anticipated by United States Patent Number (USPN) 3,840,352 to Scheffel et al., hereinafter 'Scheffel', is maintained for the reasons previously made of record in item 13 on page 7 of OA.
5. The 35 U.S.C. 102 rejections in items 14 and 15 on pages 9 and 10 of OA, respectively, as anticipated by United States Patent Application Number 2002/0166995 A1 to Robinson et al., hereinafter 'Robinson' and by USPN 3,682,249 A1 to Fischer et

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al., hereinafter 'Fischer', have been withdrawn in view of Applicant's amendment to the claims in Response.

6. The 35 U.S.C. 103(a) rejection of claims 9-11 as unpatentable over Krull in view of Scheffel is maintained for the reasons previously made of record in item 16 on page 11 of OA.

***Claim Rejections - 35 USC § 112***

7. **The text of those sections of Title 35, U.S. Code that is not included in this action can be found in the previous Office action.**

8. Claims 3 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because they depend from claim 2 or claim 4, both of which have been cancelled.

9. Claims 12 and 13 (and claim 14 that depends from claim 13) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 13 recite the limitation "the strong wax solvent " in line 3. There is insufficient antecedent basis for this limitation in the claims.

***Response to Arguments***

***The Specification and the 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> Paragraph Rejections in items 2, 6 and 9-12 of OA***

10. Applicant's arguments regarding the "objections" to the specification (item 6 of OA) and the captioned 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections (items 2 and 9-12) have been considered but have become moot due to the withdrawal of these rejections in view of Applicant's amendment to the specification and claims in Response.

***The 35 U.S.C. 112, 1st Paragraph Rejections (item 8 of OA)***

11. Applicant's arguments with respect to the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection of claims 1, 3, 5-7 and 9-21 have been fully considered but deemed unpersuasive.

The instant claims are rejected under 35 U.S.C. 112, first paragraph, because (as stated previously in item 8) the specification, while being enabling for ethylene vinyl acetate (EVA) copolymers, does not reasonably provide enablement for *modified* EVA copolymers. That is, the specification does not provide one skilled in the art with sufficient guidance as to how to make the invention commensurate in scope with the instant claims. Particularly, as discussed previously in OA, the specification does not disclose what the modification of EVA is, what modification of EVA is necessary, or how to "modify" the *modified* EVA copolymer recited in claim 1, to be able to practice the claimed invention.

Applicant argues in Response that:

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"The term 'modified eva' is a term coined by EXXON® Corporation. It is the belief of the Applicants that the modified eva's being marketed by EXXON® ... are likely to be within the scope of eva polymers. Unfortunately, since the Applicants cannot make this inquiry, *they must assume that there is at least a possibility that a change has been made to the polymer that might take it outside of the scope of the meaning of eva polymers*, especially if EXXON® is successful in getting this term adopted as a term of art. ... In view ... that Applicants are aware ... that EXXON® is marketing the modified eva polymers and that "modified eva polymers" *has a meaning in the art as already set forth*, the Applicants respectfully assert that one ... in the art, upon seeing the term "modified eva polymers" would know that the term means: ... 1) a composition being marketed as a modified eva polymer; and 2) a polymer in which some of the substituent radicals have been replaced." [Emphasis added by Examiner]

These statements in Response are contradictory. Applicant acknowledges that the EVA polymers marketed by EXXON® have only "a possibility that a change has been made to the polymer that might take it outside the meaning of EVA polymers." Applicant is thus admitting that it does not "possess" the definition of the term "modified EVA" because Applicant argues that they may *possibly* contain a certain modification or, alternatively, they may not contain a certain modification. Applicant is thus uncertain as to what defines a modified EVA polymers and accordingly, as to its "meaning in the art". One skilled in the art would not be able to ascertain, in view of the instant disclosure (and especially in light of Applicant's comments) with any definiteness (without extraordinary undue experimentation) what chemical structures "modified EVA" actually encompasses.

It is unclear, for example, if the term "modified EVA" can encompass a glycol polymer derived from an EVA polymer that has been acidified/hydrolyzed (reverse esterification replacing substituents). The term "modified EVA polymer" can therefore

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be interpreted to encompass any alcohol, glycol or carboxylic acid derivative of an EVA polymer due to the lack of any guidance from the specification as to the definition of the term. Because of the indefiniteness of the term "modified EVA polymers", one skilled in the art would not be able to ascertain its definition "upon seeing the term".

Particularly, regarding EXXON® being "successful in getting this term adopted as a term of art" in the future, although the Examiner acknowledges Applicant's concerns, it is however for examination purposes outside the jurisdiction of the Examiner to consider and/or determine "equivalents" for a claim term that may possibly appear in the future.

Thus, the instant claims, as amended, remain rejected as not enabled by the specification in accordance with 35 U.S.C. 112, first paragraph.

The 35 U.S.C. 102 Rejection over Krull (item 4 of OA)

12. Applicant's arguments filed regarding the 35 U.S.C. 102(e) rejection of claims 1, 3, 5-7 and 12-21 as anticipated by Krull have been fully considered but are deemed unpersuasive.

Applicant's primary response to this rejection is that claim 1 (sole independent claim) has been "amended to use a 'consisting essentially of' transition thus limiting the solvents to those listed and *only insignificant amounts of other solvents that would not materially affect the properties of the claimed composition*". [Emphasis added] This argument is misguided.

There is no explanation in the specification as to what materials/solvents the transition phrase "consisting essentially of" is excludes from the claimed inhibitor

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composition. Moreover, independent claim 1 does not recite any percentages for the solvent components of the claimed composition. Accordingly, the claimed composition can contain, for example, a solvent system having minor amounts of "mixtures" such as benzene, toluene, xylene, ethyl benzene, propyl benzene, trimethyl benzene, cyclopentane, cyclohexane, carbon disulfide AND/OR decalin, all of which are recited in the claim (which is a "mixture thereof" that will not materially affect the composition). As discussed previously in OA, Krull discloses a solvent system containing toluene and naphtha, wherein naphtha contains decalin, cyclopentane and cyclohexane. (See, page 7, lines 10-15 of the Office Action of March 13, 2006) Krull is therefore disclosing a solvent system having a mixture of toluene, cyclohexane, cyclopentane and cyclohexane, which is encompassed by the "solvent system" recited in claim 1.

Examiner notes at this time that claims 9-11 recite ratios for the "first solvent" and "second solvent" of claim 1. However, claim 9 (reciting a ratio of first to second solvent from about 6:1) would read on a composition having, for example, 6% toluene, 1% cyclohexane and the balance (93%) of other solvents. In addition, the terms "first solvent" and "second solvent", in its broadest interpretation, do not exclude any solvents whatsoever and thus can include a "complex solvent", such as naphtha.

In response to Applicant's arguments "that Krull does not disclose an actual preparation", the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson,



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397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)). ... "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. MPEP 2123

Thus, the instant claims, as amended, are interpreted as reciting open-ended transitional language and remain anticipated by Krull.

The 35 U.S.C. 102 Rejection over Scheffel (item 13 of OA)

13. Applicant's arguments filed regarding the 35 U.S.C. 102(b) rejection of claims 1, 3, 5-7 and 9-21 as anticipated by Scheffel have been fully considered but are deemed unpersuasive.

As discussed previously regarding Krull, the specification is unclear as to which additives/solvents the "consisting essentially of" transition language is excluding and which additives/solvents materially affect the properties of the claimed inhibitor composition. Accordingly, this transition language in claim 1 is being interpreted as open-ended transitional language.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which Applicant relies (i.e., "specific binary system mixtures") is not recited in the rejected claim(s). Although

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the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As stated above, independent claim 1 reads on a mixture of several (more than two) solvents and is not necessarily limited to a system of only two solvents. Besides, claim 1 recites that the "first solvent" and the "second solvent" can each be a "mixture thereof", which is, of course, at least four solvents.

Regarding Scheffel not "favor[ing] binary solvents" and not disclosing an "actual combination of two solvents", as stated above regarding Krull, the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. MPEP 2123

Thus, the instant claims, as amended, are interpreted as reciting open-ended transitional language and remain anticipated by Scheffel.

The 35 U.S.C. 102 Rejections over Robinson and Fisher (items 14 and 15 of OA)

14. Applicant's arguments filed regarding the 35 U.S.C. 102 rejections as anticipated by Robinson and by Fisher have been considered but have become moot due to the withdrawal of these rejections in view of Applicant's amendment to the claims in Response.

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The 35 U.S.C. 103 Rejection over Krull and Scheffel (item 16 of OA)

15. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of **claims 9-11** as unpatentable over Krull and Scheffel have been fully considered but are deemed unpersuasive.

Applicant's specific arguments in Response concerning the rejections over Krull and over Scheffel were discussed previously in paragraphs #12 and #13, respectively.

Regarding Applicant's argument that the claims "are not obvious in view of the combination of Krull and Scheffel [because] [n]either reference recognizes nor teaches *the synergistic advantage of pour point depression of the binary solvents as presently claimed in the currently amended Claim 1*", Examiner has failed to find this limitation regarding pour point depression in independent claim 1 or in the instant rejected claims (claims 9-11). Limitations from the specification are not read into the claims for examination purposes.

Nevertheless, because the composition in Krull and Scheffel, and that encompassed by the instant claims, are the same composition, then both compositions must have the same physical properties, such as pour point depression.

Thus, the claims, as amended, remain unpatentable over Krull and Scheffel.

**Conclusion**

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

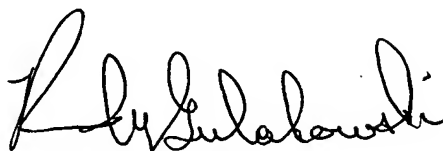
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG

  
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